REMARKS

By this Amendment, Applicants amend claim 1 to more appropriate define the present invention. Claims 1-4 and 7-20 are pending in this application.

In the last Office Action, the Examiner rejected claims 1-4 and 6-20 under 35 U.S.C. § 103(a) as unpatentable over Saylor et al. (U.S. Patent No. 5,487,139) in view of Tamano et al. (U.S. Patent No. 6,032,157). Applicants respectfully traverse the rejection for at least the following reasons.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. *See* M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. *See* M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. *See* M.P.E.P. § 2143 (8th ed. 2001).

Claim 1, as amended, recites a "method for manipulating a map using a data processing system" including, among other things, "making a first annotation on a first region of the first map; determining a geographic region on the second map corresponding to the first region; and adding a second annotation to the second map at the determined geographic region." Saylor and Tamano, taken alone or in combination, do not disclose or suggest at least these features.

Instead, the Saylor system uses a vector database to create a vector map that is aligned with a raster map produced from an existing hand-drawn map. An existing cartographic drawing is scanned to create the raster map. See col. 4, lines 51-53. Vector information corresponding to the raster map is received from a vector background database to generate the vector map. See col. 5, lines 15-20. The raster map and the vector map are then aligned. See col. 5, lines 29-31. Once the maps are aligned, the system retrieves X, Y coordinate information for a power service interruption location, and displays that location so as to appear overlapped on the raster map. See col. 7, lines 40-52. Accordingly, as described by Saylor, two maps are first aligned, and then a location is displayed on the aligned maps.

This system, therefore, does not teach or suggest Applicants' claimed "method for manipulating a map using a data processing system" including, among other things, "making a first annotation on a first region of the first map; determining a geographic region on the second map corresponding to the first region; and adding a second annotation to the second map at the determined geographic region."

In making the rejection, however, the Examiner alleges that Saylor teaches adding the second annotation to the second map, citing col. 1, lines 30-50 and col. 7, lines 40-60. See Office Action, page 14. The Examiner refers to examples, such as "posting an event marker at an appropriate location on the appropriate map, adding a marker, a colored pin for the interruptions/disturbances, the aligned territory on the raster scanned map and/or vector map." See Office Action, page 14. Applicants respectfully disagree with these allegations by the Examiner.

In particular, Saylor discusses manual prior art methods whereby one used a colored pin or other type of marker to post a location on a paper map. See col. 1, lines 39-41; see also col. 1 lines, 29-31 ("These distribution maps may be large, extending for example from floor to ceiling and wall to wall."). Applicants respectfully submit, that this teaching does not disclose or suggest Applicants' claimed step of "adding a second annotation to the second map at the determined geographic region." In addition, Applicants respectfully submit that this portion of Saylor is not a part of the method implemented by the Saylor system that was discussed above. Instead, it is a discussion of prior art manual methods that Saylor discusses as an example of prior art.

Furthermore, in the other portion cited by the Examiner, the Saylor system merely displays a location on a display monitor and/or wall via a projector so as to appear overlapped on the raster scanned map. See col. 7, lines 48-51. At this point, the two maps have already been aligned. Accordingly, Saylor does not disclose or suggest a "method for manipulating a map using a data processing system" including, among other things, "making a first annotation on a first region of the first map; determining a geographic region on the second map corresponding to the first region; and adding a second annotation to the second map at the determined geographic region," as recited in claim 1. By contrast, Saylor describes aligning two maps, and then displaying a location on the two aligned maps.

Nor does Tamano make up for the deficiencies of Saylor. Tamano discloses a system in which a user links two images, such as maps, by choosing a correspondence between objects on the images. The link enables the user to retrieve previously stored attribute information about the corresponding objects. See col. 2, lines 40-52. To link

two images, the user views the images and inputs the correspondence "by selecting an object in the second image information." See col. 2, lines 40-52. The Tamano system thus involves two images that contain objects already present on the two images before determining a correspondence between the images. See col. 4, lines 6-25.

Accordingly, Tamano does not make up for the shortcomings of Saylor. In particular, the applied prior art references, alone or in combination, do not disclose or suggest a "method for manipulating a map using a data processing system" including, among other things, "making a first annotation on a first region of the first map; determining a geographic region on the second map corresponding to the first region; and adding a second annotation to the second map at the determined geographic region," as recited in claim 1.

Moreover, even if Saylor and Tamano were to disclose all of the features of claim 1, which Applicants respectfully dispute for at least the reasons set forth above, there is nevertheless no motivation to make the combination proposed by the Examiner. In particular, as discussed above, Saylor discloses first aligning maps and then displaying a location on the aligned maps. Tamano discloses a system in which a user links two maps by choosing a correspondence between objects on the maps so the user may retrieve previously stored attribute information about the corresponding objects. One of skill in the art would not have been motivated to combine the map alignment of Saylor with Tamano's linking of attribute information. In contrast, the cited references teach away from such a combination because Saylor discloses first aligning maps in order to determine a correspondence. Once the maps are aligned over each other, there is no longer a need to link attribute information between corresponding locations.

Consequently, there is no reason for one to link attribute information to determine corresponding locations in the manner described in the Tamano system because Saylor describes aligning maps for this very same purpose. For example, Saylor describes that its techniques provide for adapting existing, hand drawn drawings and other preexisting information for intelligent display on a graphics monitor or other viewing means. See col. 7, lines 60-64.

In this regard, Applicants respectfully points out to the Examiner it "is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." See In re Wesslau, 147 U.S.P.Q. 391 (C.C.P.A. 1965). See also M.P.E.P. § 2141.02, p. 2100-120. By contrast, the required motivation to combine references must "be found in the prior art, and not based on applicant's disclosure." See M.P.E.P. § 2143 (emphasis added).

There is thus no motivation for such a combination as proposed by the Examiner, and in addition, due to the divergent teachings of Saylor and Tamano, there is also no reasonable expectation of success for making the Examiner's proposed combination. Accordingly, for at least the above reasons, Applicants respectfully request the Examiner to allow claim 1.

Independent claims 15 and 19 include recitations similar to those of claim 1. For at least the reasons as discussed above, Saylor and Tamano, taken alone or in combination, fail to disclose or suggest claims 15 and 19. Accordingly, Applicants respectfully request the Examiner to allow claims 15 and 19.

Claims 2-4 and 7-14 depend from claim 1. Claims 16-18 depend from claim 15.

Claim 20 depends from claim 19. Because <u>Saylor</u> and <u>Tamano</u>, taken alone or in

combination, fail to disclose or suggest every element of independent claims 1, 15, and

19, these references also fail to disclose or suggest every element of the dependent

claims. Accordingly, Applicants also respectfully request the Examiner to allow claims

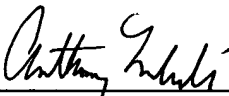2-4, 7-14, 16-18, and 20.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration

and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our deposit account 06-0916.

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Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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Dated: September 8, 2004   By _____

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